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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/811,221	03/16/2001	Edward G. Tiedemann JR.	PA579C1	3117

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Qualcomm Incorporated
Patents Department
5775 Morehouse Drive
San Diego, CA 92121-1714

EXAMINER

SAM, PHIRIN

ART UNIT	PAPER NUMBER
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2661

DATE MAILED: 08/05/2004

3

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/811,221

Applicant(s)

TIEDEMANN, EDWARD G.

Examiner

Phirin Sam

Art Unit

2661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-21 are rejected under the judicially created doctrine of double patenting over claims 1, 21, 29, 54, 57, 58, and 60 of U. S. Patent No. 6,275,478.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant applicant's claims 1, 2, 15 merely broaden the scope of claims 1, 21, 29, 54, 57, 58 of U.S. Patent No. 6,275,478.

Regarding the instant applicant's claims 1 and 2 by eliminating "(C) transmitting a message ... and the first time offset." of Patent's claim 1.

Regarding the instant applicant's claims 4 and 5 by eliminating, "simultaneously transmitting ... the first position is mapped to the first access channel" of Patent's claim 21.

Regarding the instant applicant's claims 7-9 by eliminating, "increasing an output ... to said third state." of Patent's claim 29.

Regarding the instant applicant's claims 11-13 by eliminating, "(D) transmitting a message ... power adjustment level" of Patent's claim 54.

Regarding the instant applicant's claims 15 and 16 by eliminating, "the first power control ... to the first access channel" of Patent's claim 57.

Regarding the instant applicant's claims 18-20 by eliminating, "(E) a transmitter ... power adjustment level determined by the controller" of Patent's claim 60.

It has been held that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. In *re* Karlson, 136 USPQ 184 (CCPA). Also note *Ex parte Rainu*, 168 USPQ 375 (Bd. App. 1969); the omission of a reference element whose function is not needed would be obvious to one skilled in the art.

Regarding the instant applicant's claim 3, the subject matter claimed is fully disclosed in the patent's claim 1. Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Regarding the instant applicant's claim 6, the subject matter claimed is fully disclosed in the patent's claim 21. Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Regarding the instant applicant's claim 10, the subject matter claimed is fully disclosed in the patent's claim 29. Furthermore, there is no apparent reason why applicant was

prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Regarding the instant applicant's claim 14, the subject matter claimed is fully disclosed in the patent's claim 54. Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Regarding the instant applicant's claim 17, the subject matter claimed is fully disclosed in the patent's claim 57. Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Regarding the instant applicant's claim 21, the subject matter claimed is fully disclosed in the patent's claim 60. Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-5, 7-11, and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Ali et al (U.S. patent 5,896,411).

Ali et al discloses the invention (**claims 1, 4, 11, and 15**) as claimed including, in a communication system, a method comprising:

- (a) transmitting a power control information packet formed from a plurality of power control bits from a base station to one or more mobile stations of a plurality of mobile stations, wherein each of the power control bits in the power control information packet has a position that is mapped to a selected access channel and to a time offset within the selected access channel (see Fig. 1, elements 130-136, col. 6, lines 3-5).
- (b) controlling a transmission of signals from the one or more mobile stations to a base station on a plurality of M multiple access channels (see Fig. 1, elements 120-126, col. 6, lines 1-2, 41-61).

Regarding claims 2 and 5, Ali et al discloses receiving the power control information packet at a first mobile station (see Fig. 1, col. 6, lines 3-5).

Regarding claim 3, Ali et al discloses transmitting a message from the first mobile station to the base station on a first access channel and at a first time offset associated with the first access channel, wherein the message is transmitted from the first mobile station at a power level determined in response to a first power control bit in the power control information packet, the first power control bit is located in a first position in the power control information packet,

and the first position is mapped to the first access channel and the first time offset (see Fig. 1, col. 6, lines 1-2, 7-18).

Regarding claims 7-10, Ali et al discloses, in a communication system, a method comprising:

- (a) transmitting a power control information packet formed from a plurality of mobile stations, wherein the power control bits in the power control information packet are transmitted using a modulation that permits each of the power control bits to assume one of first, second, and third different states (see Fig. 1, col. 6, lines 1-2, 25-28)
- (b) controlling a transmission of signals from one or more of the plurality of mobile stations to a base station on one or more of a plurality of multiple access channels (see Fig. 1, col. 6, lines 41-61).

4. Claims 18 and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Sunay et al (U.S. Patent 5,940,743).

Regarding claims 18 and 19, Sunay et al discloses, in a mobile radio telephone system having a plurality of cells, each of the cells having at least one base station transmitter associated therewith, an apparatus for performing an access channel handoff for a mobile radio unit as the mobile radio unit moves from a first of the cells to a second of the cells, comprising:

- (a) a first base station transmitter configured for transmitting a first power control information packet including at least one power control bit from a first base station associated with the first cell to the mobile radio unit, wherein the at least one power control bit from the first base station is transmitted at a first time interval that corresponds to a first access channel (see Fig. 3, col. 9, lines 14-31).

(b) a second base station transmitter that transmits a second power control information packet including at least one power control bit from a second base station associated with the second cell to the mobile radio unit, wherein the at least one power control bit from the second base station is associated with the first access channel and with the second base station, wherein each of the power control bits in the first and second power control information packets have a position that is mapped to a selected access channel and to a base station associated with the selected access channel (see Figs. 1, 3, col. 11, lines 35-38).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3, 6, 12-14, 16, 17, 20, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sunay et al (U.S. Patent 5,940,743) in view of Xu et al (U.S. Patent 6,005,854).

Regarding claims 3, 6, 12-14, 16-17, and 20-21, Sunay et al discloses all limitations. On the other hand, Sunay et al does not disclose a controller at the mobile radio unit configured for determining a state of the at least one power control bit from the first base station, a state of the at least one power control bit from the second base station, the controller also determining an output power adjustment level in response to the state of the at least one power control bit from the first base station and the state of the at least one power control bit from the second base station. However, Xu et al discloses a controller at the mobile radio unit configured for

determining a state of the at least one power control bit from the first base station (see Fig. 6-10, col. 10, lines 55-64, col. 11, lines 21-54). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine a controller at the mobile radio unit configured for determining a state of the at least one power control bit from the first base station teaching by Xu et al with Sunay et al. The motivation for doing so would have been to provide to reduce overhead. Therefore, it would have been obvious to combine Xu et al and Sunay et al to obtain the invention as specified in the claims 3, 6, 12-14, 16, 17, 20, and 21.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(1) Walton, Jr. et al (U.S. Patent 5,621,723) discloses power control in a CDMA network.

8. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Phirin Sam whose telephone number is (703) 308 - 9294. The Examiner can normally be reached on Monday - Friday from 8:30AM - 4:00PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Douglas W. Olms can be reached at (703) 305 - 4703. The fax number for the organization where this application or proceeding is assigned is (703) 872 - 9306.

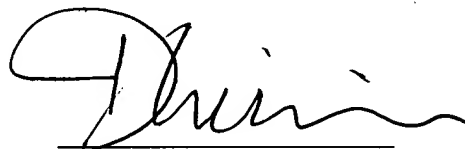
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217 - 9197 (toll-free).

Respectfully submitted,

Date: August 3, 2004

A handwritten signature in black ink, appearing to read 'Phirin', written over a horizontal line.

Phirin Sam
Patent Primary Examiner